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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,010	02/23/2004	Scott Sarem		2506

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VLADIMIR KHITERER  
KHITERER LAW OFFICE  
2109 W. COAST HWY., SUITE 200  
NEWPORT BEACH, CA 92663

EXAMINER
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WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/784,010

Applicant(s)

SAREM, SCOTT

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 102/103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lewis et al. (5,571,055). Regarding claim 1, Lewis et al. discloses a golf tee (10) comprising an elongated shank (14) having a pointed end (24) and a ground penetration stopping means (20). Note column 4, lines 33-35 stating that the tee is formed from a molded plastic resin. Thus, the end product of Lewis et al. appears to be the same as that of the claimed product. The recitation for the particular process for forming the molded tee is directed to the method of the tee's production. Attention is directed to MPEP 2113 where, "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 2, the axis of the stopping means (20) is in line with the axis of the shaft and the top and bottom surfaces are perpendicular to the axis of the shaft.

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al. (5,571,055). Regarding claims 3-5, note column 3, lines 51-56 stating that the disc may be manufactured anywhere along the length of the shaft of the tee. It would have been obvious to one of ordinary skill in the art to form the disc at the recited distances from the ball support

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surface in order to manufacture multiple variations of the tee, each having a specific distance between the base feature and the ball supporting structure of the tee.

Regarding claims 6 and 7, it would have been obvious to one of ordinary skill in the art to manufacture the disc of Lewis et al. in the range as recited by claim 6 or the value as recited by claim 7 as the applicant has not shown the criticality for the particular diameter by demonstrating a new and unexpected result obtained therefrom and it appears that the disc of Lewis et al. would accomplish similar purposes.

### ***Response to Arguments***

5. Applicant's remarks filed March 28, 2005 have been fully considered but are deemed to be moot in view of the new grounds of rejection. The applicant amended independent claim 1 to define the shaft and stopping means as being a unitary molded piece. This new limitation required the new grounds of rejection as set forth above over Lewis et al.

Regarding the Declaration submitted by applicant, the applicant states that new and unexpected results are achieved by the prescribed heights as set forth in claims 3-5. The applicant asserts that these specific heights correspond to particularly sized golf club heads to achieve unexpected results. The applicant refers to an Exhibit "A" as evidence thereof. However, the Declaration is not persuasive as while the prescribed heights may achieve improved results with certain sized golf club heads, this showing is not considered to be new and unexpected. A new and unexpected result is one that is different in kind and wholly unexpected. However, here, the applicant is merely matching a particularly sized golf club head to a particular height tee. Attention is directed to column 3, lines 51-56 of Lewis et al. stating that the base may be manufactured at any point along the spine of the tee. Clearly, through routine

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experimentation one of ordinary skill in the art would find an optimum tee height for a particularly sized golf club head. Attention is directed to *In re Aller* 105 USPQ 233. It is also noted that while applicant refers to Exhibit A, such has not been supplied in the applicant's response.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

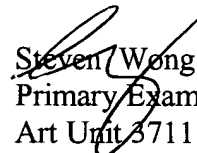
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Wednesday 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven Wong  
Primary Examiner  
Art Unit 3711

SBW  
June 6, 2005